

REMARKS

Claims 1-13 are pending in this application. Claims 1 and 5 are amended and Claims 3 and 4 are cancelled herein.

Claims 1, 5 and 11 are independent.

Claims 1 and 5 are amended to recite features previously recited in claim 3, which is accordingly cancelled, and to make minor editorial changes and clarifications. Accordingly, it is respectfully requested that the amendment to the claims, although after a final rejection, be entered. It is further respectfully noted that, as will be discussed in detail below, entry of the amendment is also proper because the Official Action to which this response relates fails to present prima facie support for the final rejection of the claims over the prior art.

Claims 11-13 stand restricted and withdrawn, as directed to an invention that is independent or distinct from the invention originally claimed. The restriction and withdrawal are respectfully traversed.

Claims 11-13 are related to claims 1-10 as a process and an apparatus used in the practice of the process. "Related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art)." (See MPEP 802.01) A "[p]rocess and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another materially different process." (See MPEP 806.05(e)) "The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given." (See MPEP 808.01)

However even if the inventions are distinct, the Examiner must keep in mind that "[e]very requirement to restrict has two aspects: (A) the reasons (as distinguished from

the mere statement of conclusion) why *each invention as claimed* is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections.” (See MPEP 808.01) Therefore, even if it can be established that the invention of claims 1-10 and claims 11-13 are distinct, “the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(A) **Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search. Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.” (See MPEP 808.02) “Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.” (See MPEP 811)

In view of the above, it is respectfully submitted that the restriction (and hence the withdrawal) is improper for failing to comply with the mandates set forth in the MPEP. More particularly, in support of the restriction, the Official Action presents only a mere statement of conclusion, and not the required concise statement of the particular reasons relied on by the examiner for holding that the inventions as claimed are distinct. As explicitly highlighted in the MPEP, a mere statement of conclusion is inadequate. Furthermore, the Official Action fails to present any reasons why insisting on restriction is necessary. More particularly, the Examiner fails to establish that the inventions of claims 1-10 and 11-13 require separate classification, have a separate status in the art, or require different fields of search.

Accordingly, it is respectfully requested that the restriction and withdrawal of claims 11-13 be reconsidered and withdrawn.

Claims 1 and 5 are objected to on informality grounds. Claims 1 and 5 are amended as suggested. Accordingly, it is respectfully requested that the objection be reconsidered and withdrawn.

Claims 1-10 stand provisionally rejected on the basis of non-statutory double patenting over claims 13-16 of U.S. application serial number 10/697,256. The rejection is respectfully traversed.

Independent claim 1 requires a shielding control device for controlling the shielding device in either a state that a player can see the symbols or a state that the player cannot see the symbols so that a stopping order is indicated, by controlling the shielding device such that (i) a display area of the reel that is to be stopped is in the state that the player can see the symbols on the reel and (ii) display areas of other reels that are not to be stopped are in the state that the player can not see the symbols on those reels.

Independent claim 5 requires that the shutter is controlled such that the portion of the symbols is shielded or shown through the panel so that a stopping order is indicated by controlling the shutter such that a display area of the reel having the portion of symbols (i) is not shielded if the reel is to be stopped and (ii) is shielded if the reel is not to be stopped.

Independent claim 11 requires, prior to the player directing the stopping of the varying symbols in one of the multiple groups of symbols, simultaneously shielding the displayed varying symbols in all of the multiple groups of symbols from the player, except for the displayed varying symbols in the one group of symbols.

On the other hand, claim 13 of the '256 application recites that the shielding control device performs, in accordance with a kind of stopping operation by the player.

Therefore, the basis for the contention that the limitations of claims 1 and 5 (and presumably 11) of the present application are equivalent to those of claims 13-15 of the '256 application is unclear and, as best understood, lacks the requisite support.

Furthermore, as amended, each of claims 1 and 5 now recites special game control means for causing a special state that is advantageous to the player under a predetermined condition. Claim 1 also recites that the shielding control device controls the shielding device during the special gaming state (as previously recited in claim 3 of the present application (now cancelled). Claim 5 also recites that the shutter is controlled during the special gaming state.

These features do not correspond to any feature of claim 13 of the '256 application and accordingly further distinguish the present claims 1-10 over claim 13. Since claims 14-15 are not specifically applied in support of the rejection, the Examiner's position regarding the relevance of these claims with respect to the rejection of the present application claims is necessarily entirely unclear.

Accordingly, it is respectfully requested that the provisional rejection of claims 1-10 on the basis of non-statutory double patenting be reconsidered and withdrawn.

Claims 1-10 stand rejected under 35 USC §103(a), as obvious over previously cited Nishikawa (JP Publication No. 2000-300729) in view of newly cited Minoura (Japanese Patent Publication No. 07-124290). The rejection is respectfully traversed.

As discussed in the response, filed on January 3, 2007, to the immediately prior Official Action dated October 3, 2006, before amendment herein, independent claim 1 required a shielding control device for controlling the shielding device in either a state that a player can see the symbols or a state that the player cannot see the symbols so that a stopping order is indicated, by controlling the shielding device such that (i) a

display area of a reel that is to be stopped is in the state that the player can see the symbols on the reel and (ii) display areas of other reels that are not to be stopped are in the state that a player can not see the symbols on those reels.

Independent claim 5 required a shutter controlled such that the portion of the symbols is shielded or shown through the panel so that a stopping order is indicated by controlling the shutter such that a display area of a reel having the portion of symbols (i) is not shielded if that reel is to be stopped and (ii) is shielded if that reel is not to be stopped.

The present Official Action acknowledges that Nishikawa lacks these limitations, and proposes to modify Nishikawa based on the teachings of Minoura so as to meet these limitations.

However, contrary to the assertions in the Official Action, Minoura lacks any teaching or suggestion of shielding so that a stopping order is indicated by executing a control such that a display area of a reel having the portion of symbols (i) is not shielded if that reel is to be stopped and (ii) is shielded if that reel is not to be stopped.

Rather, in paragraphs 23-26 Minoura explicitly teaches that no reels are shielded before all reels have been stopped. As described in paragraph 29, after all reels have been stopped and if a "big bonus" has materialized by display of a hit pattern (e.g. by the display of 7-7-7 on Rhine 63), shielding is provided so that the hit pattern is emphasized.

Therefore, it is respectfully submitted that the limitations of each of independent claims 1 and 5 (and for that matter also independent claim 11) patentably distinguish over the applied combination of art.

As proposed herein, claim 1 is further amended to add features previously recited in dependent claim 3 (which is now accordingly cancelled) and for clarification. Claim 5 is also further amended to add limitations somewhat similar to those previously recited in claim 3, and for clarification. Accordingly, these claims, as amended, are even further distinguishable over the applied prior art.

Accordingly, it is respectfully requested that the prior art rejection be reconsidered and withdrawn.

Docket No.: 3022-0020
Client No.: ARF-016US
Applicant No.: P02-0421US
File No.: 1227.43065X00

PATENT

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No.1227.43065X00) and please credit any excess fees to such Deposit Account.

Respectfully submitted,
ANTONELLI, TERRY, STOUT & KRAUS, LLP

/Alfred A. Stadnicki/

Alfred A. Stadnicki
Registration No. 30,226

1300 North Seventeenth Street
Suite 1800
Arlington, VA 22209
Tel.: 703-312-6600
Fax.: 703-312-6666

AAS/kbl